## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Tom L. Bogart, David A. Eatough,
Peter E. Johnson, Gregory P. Olsen
and Chris D. Russell

Appeal No. 2006-0969
Application No. 09/677,461

ON BRIEF

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
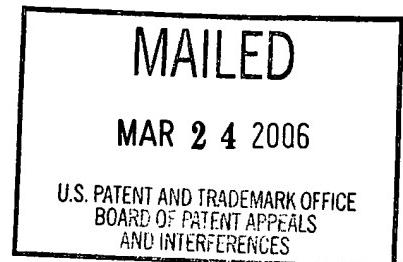
Before THOMAS, KRASS, and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the twice-rejected claims
1-29.

The invention is concerned with data transfer techniques using multiple protocols, best illustrated by reference to representative independent claim 1, reproduced as follows:

1. A method comprising:

transmitting data over a network using a first network protocol from a host electronic system to one or more target electronic systems;

determining data not received by at least one of the target electronic systems using the first network protocol; and

requesting, from the host electronic system, the data not received by at least one of the target electronic systems be transmitted using a second network protocol.

The examiner relies on the following references:

Kalwitz et al. (Kalwitz)	5,784,622	Jul 21, 1998
Willis et al. (Willis)	6,385,647	May 7, 2002
		(Filed Aug. 18, 1997)

Claims 1-29 stand rejected under 35 U.S.C. § 103 as unpatentable over Willis in view of Kalwitz.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The examiner explains, at page 3 of the Office action mailed April 9, 2004, that Willis teaches the subject matter of instant claim 1 but for the use of a second network protocol to transmit

data not received by at least one of the target electronic systems. The examiner turns to Kalwitz for a teaching of a multiprotocol operation of a networked peripheral where first and second servers are linked to respective operating systems across a local area network (LAN) through respective first and second protocol stacks.

The examiner concluded that it would have been obvious "to use a second network protocol with Willis et al. method of transmitting data to improve scalability and economy through the use of the industry standard non-proprietary software transport mechanism (IP) at the receiving facility" (Office action of April 9, 2004 - page 3).

Appellants' position is that the Office actions have not specifically addressed the claim limitations relating to "determining data not received by at least one target device" and "retransmission of data not received by a different network protocol than originally used to transmit the data."

In fact, appellants agree that Kalwitz discloses two transmission protocols. However, appellants assert that these two transmission protocols are not used in the manner claimed in that the first protocol is not used for a first transmission of data, with the second protocol used for retransmission of data not received during the first transmission.

With regard to Willis, appellants assert that this reference discloses multicasting of multimedia information, and that transmission using a first protocol (multicast) is disclosed, but retransmission uses the same protocol.

Thus, appellants conclude that since Kalwitz discloses transmission from different devices using different protocols and Willis discloses transmission and retransmission using the same protocol, nothing in this combination teaches or suggests transmitting data using a first protocol, determining data not received using the first protocol and then requesting retransmission of the data not received via a second protocol.

The examiner's response is to point out that the claims do not specify that the first and second protocols are different. Therefore, the examiner concludes that the claimed first and second protocols could be the same protocol, but implementing tasks such as transmission and retransmission at different times.

At page 4 of the answer, after explaining that Willis discloses transmission and retransmission at column 4, lines 36-42, and that Kalwitz discloses a sequence of events (in Figure 7 and at step S15 (in Figure 5B?)) using two different protocols, the examiner explains that "by combining the teaching of Willis et al. at col. 4-lines 36-42 and also at the same time step S-15 of Kalwitz et al. the motivation to achieve the appellant claimed invention is achieved."

We have reviewed the evidence in this case, including the disclosures of the applied references and the arguments of appellants and the examiner, and we conclude that the examiner has failed to establish a prima facie case of obviousness with regard to the instant claimed subject matter.

First, we are unsure of the examiner's basis for
combinability of the references. The examiner's explanation at
page 4 of the answer is confusing because under 35 U.S.C. § 103,
one does not combine references to achieve motivation, as
indicated by the examiner. Rather, the skilled artisan must have
been led, or motivated, by something in the references, or
his/her knowledge of the art, to make the proposed combination.
The combination does not lead to the motivation. On the
contrary, there must be something that would have motivated the
artisan to make the combination.

The examiner's earlier rationale for the combination, viz.,
"to improve scalability and economy through the use of the
industry standard non-proprietary software transport mechanism
(IP) at the receiving facility" is a very general allegation
unsupported by any evidence and short on any specifics as to
what, exactly, would have led the artisan to modify Willis in
order to use two different protocols, one for transmitting data,
and the other for retransmission of data not received, rather

than the single protocol used by Willis for transmission and retransmission. Certainly, Kalwitz discloses the use of two different protocols, but Kalwitz is interested in multicasting, with transmission from different devices using different protocols, and suggests nothing about transmitting data using one protocol and then retransmitting data not received using another protocol.

With regard to the examiner's allegation that the instant claims do not require two different protocols, we disagree.

During patent prosecution, the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). Those terms found in the claims are given their broadest reasonable interpretation which is not inconsistent with the disclosure. In re Cummings, 390 F.2d 1018, 157 USPQ 47 (CCPA 1968); In re Dailey, 479 F.2d 1398, 178 USPQ 293 (CCPA 1973).

It is true that the claims do not explicitly use the term, "different" and, in a broad sense, the claimed "first" and

"second" protocols could be one and the same protocol under the explicit claim language. However, under the present circumstances, we do not find this a reasonable interpretation because it is clear from the instant specification that the two protocols are to be different, e.g., at page 4, an example of a first protocol is given as a "non-reliable protocol" while an example of a second protocol is given as HTTP, and the instant claims specifically call for a "first" protocol and a "second" protocol, rather than a "first" protocol and a "said first" protocol. While the claim would have been more specific to appellants' intentions had the recitations been a "first" protocol and a "second protocol, different from said first protocol," and such language would have been preferable, in view of the disclosure's intent that these protocols be different, of the claim recitations of two, separately labeled, "first" and "second" protocols, and of appellants' assertions that these network protocols are, indeed, "different" (e.g., page 9, line 18, and page 10, line 3 of the brief), we hold, under the facts

in this case, that the claimed "first" and "second" protocols are, indeed "different" and appellants are estopped from asserting otherwise in any possible future proceedings relating to these claims as they are bound by their admitted interpretation of the claimed "first" and "second" protocols as being "different" protocols.

Accordingly, since, in our view, the examiner has not shown a sufficient motivation for modifying Willis' teachings to use one network protocol for data transmission and another, different, network protocol to retransmit data not received, and the instant claims are interpreted as requiring two "different" protocols, we will not sustain the examiner's rejection of claims 1-29 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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ALLEN R. MACDONALD)
Administrative Patent Judge)
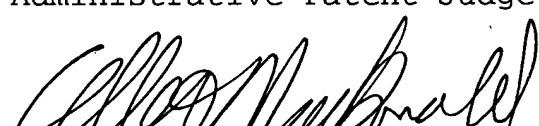
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